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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,369	02/04/2000	Victor H. Shear	07451.0010-01000	8725

22852            7590            01/21/2003

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EXAMINER

DIXON, THOMAS A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/498,369	SHEAR ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas A. Dixon	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 November 2002.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 151-155 and 186-195 is/are pending in the application.
- 4a) Of the above claim(s) 1-150 and 156-185 is/are withdrawn from consideration.
- 5) Claim(s) 151-155 and 186-190 is/are allowed.
- 6) Claim(s) 191-195 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 February 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |                                                                                                                   |                                                                             |
|-------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10 1/2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The IDS filed 22 March 2002 has been considered.

### ***Response to Arguments / Amendment***

2. Applicant's arguments regarding claim 151 and its dependents are convincing.  
Applicant's arguments regarding new independent claim 191 are not convincing.  
Figures 7A-D and the supporting column 20, line 55 – column 21, line 24, specifically column 21, lines 4-8 seen to disclose assigning the potential user to the class, the assignment being based at least in part on the potential user's use of the content.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 193 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 2 refers only to the "user's previous use" rather than the "user or recipient's previous use" as in the parent claim and line 3 which refers to the "user or recipient".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 191-195 are rejected under 35 U.S.C. 102(e) as being anticipated by Erickson (5,765,152).

As per Claim 191, 195.

Erickson ('152) discloses:

assigning the potential user to the class, the assignment being based at least in part on the potential user's use of the content, see figure 7A-D and column 20, line 55 – column 21, line 24, specifically column 21, lines 4-8;

creating a secure container, see column 4, line 61 – column 5, line 4;

associating a first rule with the secure container, the rule at least in part governing use of at least some of the secure container contents, the first rule at least in part specifying potential users or recipients of the secure container contents, the specification being based at least in part on a class to which the potential users or recipients have been assigned, see figure 7D;

sending the secure container to a first remote party, see figure 1, (10);

the first remote party embedding a content object in the secure container, see column 9, lines 7-23;

sending the secure container, including the embedded content object, to a second remote party, the second remote party consisting of a potential user, see figure 1 (10);

evaluating a digital certificate associated with the potential user, see column 24, lines 45-52;

determining, based at least in part on the digital certificate, that the potential user has been assigned to a class, see column 24, lines 47-52;

based on the determination, and at least in part under control of the first rule, making at least some of the secure container contents available to the potential user, see column 24, lines 53-56.

As per Claim 192.

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Erickson ('152) does not specifically disclose the information regarding the potential user or recipient's previous use of content comprises information regarding the type of rights management information associated with the content items.

However, Erikson ('152) suggests tracking the user's previous requests, see column 21, lines 4-8 for the benefit of minimizing fraud.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use collected transaction data for any purpose be it minimizing fraud or enhancing customer service by providing a customized interaction.

As per Claim 193.

Erickson ('152) does not specifically disclose the information regarding the potential user or recipient's previous use of content comprises information regarding the type of content previously used.

However, Erikson ('152) suggests tracking the user's previous requests, see column 21, lines 4-8 for the benefit of minimizing fraud.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use collected transaction data for any purpose be it minimizing fraud or enhancing customer service by providing a customized interaction.

As per Claim 194.

Erickson ('152) further discloses a second remote party which collects information, see column 21, lines 41-49.

#### ***Allowable Subject Matter***

5. Claims 151-155, 186-190 are allowed.

6. The following is an examiner's statement of reasons for allowance:

As per Claim 155.

The prior art of record, specifically Erikson ('152) does not disclose or fairly teach receiving a request for a content object from a potential user or recipient, the request specifying a desired class of rights management information;

determining that the first content object has rights management information associated with it that belongs to the desired class; and

sending the secure container, including the embedded first content object, to the potential user or recipient.

The claims which depend from the above allowed claims are allowed for the same reasons.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Thomas A. Dixon  
Examiner  
Art Unit 3629

January 20, 2003